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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,601	10/26/2001	Franco R. Negri	01-PAN-01	3775
30827	7590	01/31/2006	EXAMINER	
MCKENNA LONG & ALDRIDGE LLP			DANIELS MENDEZ, PHYLLIS A	
1900 K STREET, NW			ART UNIT	
WASHINGTON, DC 20006			PAPER NUMBER	

3629

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/035,601	<b>Applicant(s)</b> NEGRI, FRANCO R.	
	<b>Examiner</b> Phyllis A. Daniels-Mendez	<b>Art Unit</b> 3629	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The inventor provided information explaining the figures, which are located within the application. However, one of ordinary skill in the art would not understand how to make and/use the invention. For example, if one wanted to construct an e-Shopping website; what would one need to do in order to perform this task? What type of infrastructure would be needed to implement in order to sustain a certain capacity of customers that would use this particular site? What type of information should come out of the derivation of the e-Service Management Strategy? More concrete information is necessary in order to duplicate the inventor's findings.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: Lines 10-11 of claims, this statement incorporating the needs imposed by the business process in the criteria for managing said infrastructure" is the same as Lines 8-10.

Claim 2: Line 15 of claims: What are the types of Infrastructure behavior(s) being referred to?

Claim 2: Lines 19-20 of claims: What are some of the key components that need to be analyzed?

Claim 2: Lines 21-23 of claims: Optimization was not discussed in the specification. The Examiner is unsure of how to perform this task in relation to the eService Model.

Claim 2, line 17 provides for the use of "stress behavior", but, since the claim does not support what has been written in the specification, it is unclear what the method/process the applicant is intending to present.

Claim 3: Lines 1-3 of claims: What are the different types of infrastructure events that should be observed at different periods of time?

Claim 4: Lines 5-6: If the infrastructure comprises at least one of e-service, services, applications, systems, components, and resources. Can the applicant provide some examples of the terms that have been listed previously?

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Claim 1, fails to set forth a Concrete & Tangible result. The e-Service Management Strategy is never derived. The steps are listed on how to derive, but the information that would be used during the derivation process would be subjective.

As to Claim 2, "Stress Behavior" has not been discussed in the claims or in the specifications. The same can be said of the following terms: infrastructure behavior, as well as how to optimize this behavior.


### ***Conclusion***

No prior art has been listed because one who is skilled in the art would have difficulty nailing down some of the vital components of the invention. This is in part due to the lack of understanding of specificity of the claims and the specifications. For example, the way of managing an e-service does not contain a lot of detail. What type of stress behaviors should be observed? How can the infrastructure behavior be analyzed when it involves stress behavior, which has not been defined. It would be hard for anyone skilled in the art to repeat the process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phyllis A. Daniels-Mendez whose telephone number is 571-272-7657. The examiner can normally be reached on 8:00 a.m. - 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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